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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,229	03/24/2000	Akira Kawakami	P17156-00004	1735

7590 09/26/2003

Arent Fox Kintner Plotkin & Kahn  
1050 Connecticut Avenue N W Suite 600  
Washington, DC 20036-5339

EXAMINER
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RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 09/26/2003

28

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/534,229

Applicant(s)

KAWAKAMI ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-20,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-18,23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

#### **CONTINUED EXAMINATION UNDER 37 CFR 1.114 AFTER FINAL REJECTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-30-03 (Paper No.24, Amendment G) has been entered.

Claims 13-20, 23-24 are currently pending and are present for examination. Claims 13-18, 23-24 are now under consideration. Claims 19-20 remain withdrawn from consideration as being drawn to non-elected invention.

Applicants' amendments and arguments filed on 4-30-03, paper No. 24, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 and claims 14, 23, 24 depending therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 recites that the claimed winter

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wheat chitinase cDNA “encodes an amino acid sequence that is 98% identical to an amino acid sequence encoded by barley chitinase cDNA having a nucleotide sequence SEQ ID NO:6”. It is the last part of the phrase that is highly confusing to the Examiner. While the specification defines SEQ ID NO:6 as encoding the amino acid sequence SEQ ID NO:1, a winter wheat chitinase, the above phrase in the claim 13 indicates the barley chitinase cDNA as having the polynucleotide with SEQ ID NO:6. Therefore it is not clear to the Examiner whether the claimed cDNA encoding a winter wheat chitinase has a nucleotide sequence with SEQ ID NO:6 or whether SEQ ID NO:6 is that of a barley chitinase.

Claims 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 recites that the claimed winter wheat chitinase cDNA “encodes an amino acid sequence that is 68% identical to an amino acid sequence encoded by rye chitinase cDNA having a nucleotide sequence SEQ ID NO:7”. It is the last part of the phrase that is highly confusing to the Examiner. While the specification defines SEQ ID NO:7 as encoding the amino acid sequence SEQ ID NO:2, a winter wheat chitinase, the above phrase in the claim 15 indicates the rye chitinase cDNA as having the polynucleotide with SEQ ID NO:7. Therefore it is not clear to the Examiner whether the claimed cDNA encoding a winter wheat chitinase has a nucleotide sequence with SEQ ID NO:7 or whether SEQ ID NO:7 is that of a rye chitinase.

Claims 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Claim 13 recites that the claimed winter wheat chitinase cDNA “encodes an amino acid sequence that is 95% identical to an amino acid sequence encoded by spring wheat chitinase cDNA having a nucleotide sequence SEQ ID NO:8”. It is the last part of the phrase that is highly confusing to the Examiner. While the specification defines SEQ ID NO:8 as encoding the amino acid sequence SEQ ID NO:3, a winter wheat chitinase, the above phrase in the claim 17 indicates the spring wheat chitinase cDNA as having the polynucleotide with SEQ ID NO:8. Therefore it is not clear to the Examiner whether the claimed cDNA encoding a winter wheat chitinase has a nucleotide sequence with SEQ ID NO:8 or whether SEQ ID NO:8 is that of a spring wheat chitinase.

### ***Conclusion***


None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

  
**MANJUNATH RAO**  
**PATENT EXAMINER**

Manjunath N. Rao  
September 24, 2003